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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Timothy P. Michel
Serial No.: 10/696,643
Conf. No.: 7780
Filed: 10/29/2003
For: SCROLL COLLAR FOR
RECIPROCATING SAW

Art Unit: 3724
Examiner: Peterson, Kenneth E.

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TRANSMITTAL OF REPLY BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
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Transmitted herewith:

- (X) Appellant's Reply Brief Pursuant To 37 CFR § 41.41 with respect to the Examiner's Answer mailed on March 27, 2007.

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Dated: May 24, 2007

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APPELLANT'S REPLY BRIEF PURSUANT TO 37 CFR § 41.41

The Examiner's Answer presents a moving target with regard to the content of the rejections. The 102 anticipation rejection based on Pioch now includes newly cited Seefluth which can only be done by either misreading or misapplying § 2131 of the MPEP.

The Examiner also notes that he is not relying on “unidentified patents or any type of official notice” and that all the teaching can be found in the prior art relied upon which now does not include Biek (which has been dropped), apparently in favor of Seefluth.

The examiner now describes the 103 rejection as claims 1-3, 19 and 20 are rejected under 35 U.S.C. 103(a) over Pioch or Ginter in view of Bourke. It is noted that the prior 103 rejection of claims 1-3, 19 and 20 did not have the clarity that the examiner now characterizes the rejection. Previously, the examiner stated that “it is well known for drills to have generally cylindrical collars rotatable around their gear housings. For example, see the patents to Pioch ‘675, Ginter ‘659 and Biek ‘282 and there are dozens of other occurrences of this in the patent database. It is also well known for drills to become reciprocating saws. For example, see the patent to Bourke ‘293 and there are many other patents that show this feature. It would have been obvious to one of ordinary skill to have modified the likes of Pioch or Ginter or Biek by providing the reciprocating saw conversion of the likes of Bourke, in order to be able to saw things without having to carry around a separate reciprocating saw.

Neither the 102 or the 103 rejection should be affirmed for the following reasons.

The 102 Anticipation Rejection by Pioch Should Be Reversed.

Pioch fails to anticipate, teach or suggest claim 1 applied singularly or in combination with newly cited Seefluth. Applicant believes that the citation of Seefluth is

improper. MPEP section 2131.01 states that normally only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to show that a *characteristic* not disclosed in the reference is inherent. That section further states:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (The court went on to explain that “this modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges.” 948 F.2d at 1268, 20 USPQ at 1749-50.). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an *inherent property, function or ingredient* of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999)

The examiner improperly applies Seefluth because Pioch does not have an attached tool blade and an attached tool blade is *not* an *inherent characteristic, property, function or ingredient* of a prior art reference. As is stated in reference to the *Continental Can* case in this MPEP section, the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill.

Clearly, a tool blade is either present or not, and cannot be inherent. The claim language does not include the word “capable” so the examiner’s reference to it is believed to be irrelevant. Not only that, Seefluth does not have a tool blade attached, it is a drill bit with cutter tips 41 which are stated to be blades. However, this is a poor choice of words on the part of the author. Calling a cow a horse does not make it a horse.

The examiner has ignored the arguments made by applicant with regard to the Pioch reference. Pioch fails to anticipate, teach or suggest the scroll collar and reciprocating tool assembly as set forth in amended claim 1 because it fails to meet all of the elements of this claim as is necessary for a valid anticipation rejection. Pioch discloses an auxiliary handle for a power tool, and particularly illustrates a hammer drill tool that has a drill bit assembly 22 as described at column 2, line 56, and at column 4, lines 34-36. Pioch describes an auxiliary handle for such a tool which is capable of being attached to a barrel portion 20 of a housing. It has clamping jaws 36 and 38 provided with arcuate shaped concave clamping surfaces 62 and 64, respectively, which cooperate to define a generally annular concave recess when clamping jaws 36 and 38 are pivoted into the closed position shown in Fig. 2. (column 3, lines 45-53)

The auxiliary handle is intended to be attached to the tool and clamped in place and not be rotating during use. This is particularly stated in column 3, line 64-column 4, line 4: “Thus, to utilize the auxiliary handle 30 of the present invention, the operator simply orients the handle 30 in the desired position with the clamping means 34 and collar portion 66 in an uncompressed condition. The auxiliary handle 30 is thereafter clamped to the barrel portion 20 of the tool by rotating gripping member 32 which compresses clamping jaws 36 and 38 together to thereby compress collar portion 66 causing it to grip barrel portion 20.”

While the specification goes on to indicate that it can be placed in different orientations, it is clear that it is not intended to provide a rotating grip as is set forth in the preamble of claim 1, nor does it meet the last element of the claim which reads, “a generally cylindrical scroll collar carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis.” The present invention as claimed in claim 1 is for a reciprocating tool that has a *blade*, not a drill bit. It is also submitted that there is a significant difference between the structure of Pioch which is adjustable relative to the tool as contrasted with a rotatable scroll collar that provides a rotating grip as is claimed in claim 1.

The purpose of the rotating grip is to enable an operator to grip the scroll collar with his left hand and manipulate the tool to rotate it around the scroll collar axis to easily rotate the blade without having to reposition his hand on the gripping collar because the scroll collar is configured to rotate relative to said support structure. That is not the structure or operation of Pioch.

Another reason that the Pioch auxiliary handle does not meet the language of the claim is that its handle 32 is what is gripped by a user with the handle 32 being twisted to tighten the clamping jaws 36 and 38 around the barrel portion 20, and the handle does not satisfy the cylindrical scroll collar element as claimed because it does not rotate around a scroll collar axis.

If the support structure of Pioch is considered to be the clamping jaws 36 and 38, then Pioch has no generally cylindrical scroll collar carried by said support structure, nor does it have a cylindrical scroll collar that rotates *relative* to said support structure--the jaws and handle all rotate *together*.

Alternatively, if the support structure is interpreted to be the barrel portion 20 of the housing 12, then the *entirety* of the auxiliary handle, including the jaws 36 and 38 as well as the stud member 42 and handle 32 (i.e., everything shown in Fig. 2) cannot legitimately be considered to meet the language of a generally cylindrical scroll collar carried by said support structure.

The 103 Rejection Should Be Reversed.

The examiner has streamlined the 103 rejection to read that claims 1-3, 19 and 20 are rejected under 35 U.S.C. 103(a) over Pioch or Ginter in view of Bourke. The examiner makes a point of stating that he talked with the appellant on January 9, 2007 to discuss the rejection but appellant chose to proceed with the appeal anyway. The undersigned does recall a single conversation which is believed to be set forth in the Interview Summary that indicates the date was January 4 wherein the undersigned

discussed what is described as: “Discussed how to amend the claims to distinguish over Pioch reference by adding details about the structure of the scroll collar. Discussed how to overcome the Philips and Albrightson rejections by adding that the blade does not rotate with the collar. Discussed how to fix the defective brief.”

During that discussion it became clear that the examiner did not understand the invention and that the suggested amendments would not accurately describe the structure of the scroll collar. The claims also stated at that time that the blade did not rotate with the collar, i.e., the scroll collar was “configured to rotate relative to said support structure and an attached tool blade around a scroll collar axis.”

The arguments that are presented above with regard to the 102 rejection of Pioch equally apply to 103 rejection by Pioch. Ginter is similar to Pioch in that it has a transverse handle 20 similar to the Pioch handle 30 and therefore Ginter fails to teach or suggest the element of claim 1: “a generally cylindrical scroll collar carried by said support structure and configured to rotate relative to said support structure and an attached reciprocating tool blade around a scroll collar axis.”

The examiner states that it would have been obvious to one of ordinary skill in the art to have modified “the likes of Pioch or Ginter by attaching a reciprocating saw conversion of the likes of Rourke, in order to be able to saw things without having to carry around a separate reciprocating saw power tool.” It is still a mystery to the applicant as to why Rourke’s device for converting rotary drill motion to reciprocating saw action would be needed for a hammer saw that the examiner has already indicated moves with a reciprocating action. There is absolutely no motivation to provide


reciprocating action for a tool that already demonstrates reciprocating action. However, even if the combination were proper, Bourke does not supply the basic deficiency of either Ginter or Pioch with regard to the last paragraph of the claim which defines the generally cylindrically scroll collar element.

The dependent claims not specifically addressed necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and also should be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to issue.

Respectfully submitted,

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